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REMARKS

Claims 1 through 15 remain pending in this Application. Claims 1, 14, and 15 have each been currently amended to more clearly claim various aspects of the invention.

Although not indicated in the present Office Action, during a telephonic interview on October 4, 2004, with Supervisory Examiner Garber and Examiner Jerabek, the undersigned was advised that a hyperlink appearing in the specification on page 5 line 22 was to be removed. Accordingly, the specification has been amended on page 5, line 22 to remove the hyperlink to more specifically remove "http://www.gyration.com."

The claims as currently amended do not raise any new issues, and do not present any new matter.

"Claims 1-2, 4-7, 9-10, and 12-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Tomitaka et al. US 5,812,193 in view of Leppisaari et al. US 2002/0101517." Applicants respectfully traverse this rejection.

On page 3 of the Office Action, the Examiner clearly advises that Tomitaka et al. "... fails to distinctly state that the video camera system includes a video camera that is associated with a hand-held device." Applicants agree. In fact, the undersigned carefully reviewed the teachings of this reference, and did not find even a suggestion that the system of Tomitaka et al. can be utilized with a hand-held device, as in the present invention.

In discussing the teachings of Leppisaari et al., the Examiner advises from amongst other things that in this reference "... the terminal 40 including a thermograph 43 as shown in Figure 4 is capable of detecting movement between the terminal 40 and the object of interest and adjusting the camera settings accordingly. The terminal 40 is a hand-held device and it includes a video camera 41 (page 3, paragraph 22).

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Therefore, it would have been obvious for one skilled in the art to have been motivated to include the hand-held terminal housing a video camera disclosed by Leppisaari in the video camera system disclosed by Tomitaka. Doing so would provide a means for focusing a camera of a portable terminal at an object (Leppisaari: page 1, paragraph 8)."

5 Applicants respectfully request the Examiner to reconsider the present rejection of the claims in view of the following remarks.

Leppisaari is only concerned with focusing, that is with maintaining focusing of an object. Applicant is not claiming focusing. Also, there would be no reason for

10 Tomitaka or one of skill in the art to incorporate any of the teachings of Leppisaari into the system disclosed by Tomitaka, in that Tomitaka already uses an auto-focusing system (column 17, lines 13 through 19, and column 23, lines 30 through 38). There is nothing in the cited references that would suggest the advantage to be derived from combining their teachings.

15 The undersigned would like to bring to the Examiner's attention case law that clearly advises why Tomitaka and Leppisaari do not make Applicant's invention as claimed obvious. The courts have long held that there must be some teaching in the references cited to suggest the combination of the references in a manner to obtain

20 the combination of elements of the rejected claim(s). It is well known that in order for any prior art references themselves to be validly combined for use in a prior-art § 103 rejection, the references themselves, or some other prior art, must suggest that they be combined. For example:

25 The Board has stated in Ex parte Levengood, 28 USPQ 2d 1300 (PTOBA&I 1993):

"In order to establish prima facie case of obviousness, it is necessary for the examiner to present evidence, preferably in the form of some

30 teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in

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the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. ... That which is within the capabilities of one skilled in the art is not synonymous with obviousness. ... That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden establishing a prima facie case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references which describe various aspects of a patent applicant's invention without also providing evidence of a motivating force which would impel one skilled in the art to do what the patent applicant has done."

As was further stated in Uniroyal, Inc. v Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988),

"where prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself Something in the prior art must suggest the desirability and thus the obviousness of making the combination."

Also, the case law is clear in guarding against the use of hindsight in reading Applicants invention into the prior art, which art is clearly not disclosing the Applicants invention as claimed. Applicants would like to bring the following cases to the Examiner's attention:

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The Supreme Court in Calmar, Inc. v. Cook Chemical Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966), in which the Court warns the dangers of "slipping into hindsight", citing the case of Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co., 332 F.2d 406, 141 U.S.P.Q. 549 (6th Cir., 1964), where the doctrine is stated:

We now come to the patented device which after all is the subject matter of this case. At the outset we take note of two well-established principles.

The first is that in considering the questions of obviousness, we must view the prior art from the point in time prior to when the patented device was made. Many things may seem obvious after they have been made and for this reason courts should guard against slipping into use of hindsight. We must be careful to "view the prior art without reading into that art the teachings of appellant's invention." Application of Sporck, 301 F.2d 686, 689 (C.C.P.A).

Claims 2, 4 through 7, 9, and 10, 12, and 13 are each dependent from Claim 1 (currently amended), and as such are patentable for at least the same reasons as Claim 1 (currently amended).

Claim 14 (currently amended) and Claim 15 (currently amended) are patentable in that as has been shown above, there are no teachings in Tomitaka et al. and/or Leppisaari et al. that would lead one to combine the teachings thereof in a manner to obtain Applicants' invention as claimed.

"Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Tomitaka et al. in view of Leppisaari et al. as applied to claim 1 above and further in view of Yuyama et al. US 5,612,732." Claim 3 is patentable for at least the same reasons as Claim 1 (currently amended) from which the former depends.

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"Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Tomitaka et al. in view of Leppisaari et al. as applied to claim 1 above and further in view of Yerazunis et al. US 6,600,657."

5 Claim 8 is dependent from Claim 1 (currently amended), and accordingly is patentable for at least the same reasons as Claim 1 (currently amended).

 "Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Tomitaka et al. in view of Leppisaari et al. as applied to claim 10 above and further in view of
10 Vincent 6,195,122."

 Claim 11 is patentable for at least the same reasons as Claim 10, and Claim 1 (currently amended) from which it ultimately depends.

15 On October 4, 2004, the undersigned conducted a telephonic interview with Supervisory Examiner Garber and Examiner Jerabek. No agreement was reached at that time. However, the undersigned proposed further limits to the claims which Supervisory Examiner Wendy Garber advised would raise new issues. Also, Examiner Kelly Jerabek advised that Applicants might consider putting more detail into the claims
20 for clearly describing the association between the handheld device and the video camera. **The undersigned further amended Claims 1, 14, and 15 to include such details.** The undersigned respectfully requests that Examiner Jerabek further reconsider the arguments made herein in view of the claims as now presented.

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Applicants have shown that the claims as now presented are patentable over the cited references, whether taken individually or in any combination. Accordingly, it is respectfully requested that the claims be allowed, and the case passed to issue.

Respectfully submitted,



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